

REMARKS

The Office Action in the above-identified application has been carefully considered and this amendment has been presented to place this application in condition for allowance. Accordingly, reexamination and reconsideration of this application are respectfully requested. Initially, the double patenting rejection is noted and a terminal disclaimer will be filed in due course.

Claims 26-29 are in the present application. Claims 26-29 have been amended.

It is submitted that these claims, as originally presented, were patentably distinct over the prior art cited by the Examiner, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. Changes to the claims, as presented herein, are not made for the purpose of patentability within the meaning of 35 U.S.C. sections 101, 102, 103 or 112. Rather, these changes are submitted simply for clarification and to round out the scope of protection to which Applicants are entitled.

Claims 26-28 were rejected under 35 U.S.C. §112, first paragraph, as allegedly lacking enablement. Specifically, the Examiner alleges, "while being enabling for a multi-segmented apparatus disclosed in Figs. 12-13, does not reasonably provide enablement for 'said active, cutting surface disposed adjacent to a relief surface for capturing cutting residues or discharging residues from said tool.'" (*Office Action*, at 3).

Initially, the above-rejected element for an alleged lack of enablement is only recited in claim 27, and not recited in independent claim 26 nor its dependant claim 28. Thus, it is respectfully submitted that the Examiner reconsider and withdraw the rejection under Section 112, first paragraph, as to claims 26 and 28 in light of the claim amendments.

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In addition, the instantly claimed invention is clearly enabled as a skilled artisan would readily understand that the active, cutting surface can be disposed adjacent to a relief surface for capturing cutting residues or discharging residues without undue experimentation.

It is respectfully pointed out “the laws do not require a specification to be a blueprint in order to satisfy the requirement for enablement under 35 U.S.C. §112”. *Staehelein v. Secher*, 24 U.S.P.Q.2d 1513, 1516 (Bd. Pat. App. & Int. 1992). Indeed, a specification need not disclose – and best omits — that which is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 U.S.P.Q.2d 1331, 1332 (Fed. Cir. 1991).

The Examiner is respectfully invited to review *In re Wands*, 8 U.S.P.Q. 2d 1400 (Fed. Cir. 1988), wherein the Federal Circuit stated at 1404 that:

Enablement is not precluded by the necessity for some experimentation such as routine screening. However, experimentation needed to practice the invention must not be undue experimentation. ‘The key word is undue, not experimentation.’ The determination of what constitutes undue experimentation in a given case requires the application of standard of reasonableness, having due regard for the nature of the invention and the state of the art. The test is not merely quantitative, since a considerable amount of experimentation is permissible, if it is merely routine, or if the specification in question provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed ... [Citations omitted].

Against this background, determining whether undue experimentation is required to practice a claimed invention turns on weighing the factors summarized in *In re Wands*. These factors include, for example, (1) the quantity of experimentation necessary; (2) the amount of direction or guidance presented; (3) the presence or absence of working examples of the invention; (4) the nature of the invention; (5) the state of the prior art; (6) the relative skill of

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those in the art; (7) the predictability or unpredictability of the art; and (8) the breadth of the claims; all of which must be taken into account.

Applying *Wands* to the instant facts, it is clear that enablement exists, to wit, *inter alia*, that the quantity of experimentation necessary is low; the amount of direction or guidance presented is high; working examples are present; the relative skill of those in the art is high; and the predictability of the art is also high. Thus, the assertions in the Office Action, e.g., that the instant invention lacks enablement, are misplaced because undue experimentation would not exist.

It is respectfully submitted that Figures 12 and 13 are merely representative embodiments of the instant invention and do not limit the claims. Based on the teachings in the instant application, one of ordinary skill in the art can practice the subject matter recited in claim 27. That is, form a relief surface adjacent the cutting surface for capturing residues or discharging residues from the claimed device. Specifically, figures 3 and 5-9 describe a relief surface that is adjacent to the cutting surface that may be used for capturing cutting residues or discharging residues from the device. Thus, as undue experimentation is not necessary to practice the instant invention, the instant invention is enabled.

Therefore, in view of the foregoing, reconsideration and withdrawal of the rejections under 35 U.S.C. §112, first paragraph, are respectfully requested.

Claims 26-28 have been rejected based upon 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. The rejection is traversed.

The amendments to the claims, without prejudice, renders the rejections moot. Further, Applicant respectfully submits the amended claim is definite. Specifically, the element, "at least two components" in claim 26 is clear. The Examiner is respectfully reminded that a claim is

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definite if the scope of the subject matter embraced by a claim is clear and if the applicant has not otherwise indicated that he intends the claims to be of a different scope. *In re Borkowski*, 164 U.S.P.Q. 642 (C.C.P.A. 1970). The “distinctly claim” requirement of 35 USC § 112, second paragraph, means that the claims must have a clear and definite meaning when construed in light of the complete patent document. *Standard Oil Co. v. American Cyanamid Co.*, 227 U.S.P.Q. 293 (Fed. Cir. 1985). The test of definiteness is whether one skilled in the art would understand the scope of the claim when read in light of the specification. *Morton Int. Inc. v. Cardinal Chem. Co.*, 28 U.S.P.Q.2d 1190 (Fed. Cir. 1993). And the degree of precision necessary is a function of the subject matter claimed. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 231 U.S.P.Q. 81, 94-95 (Fed. Cir. 1986).

A skilled artisan would readily understand the meaning of “at least two components” when read in light of the specification. *See Morton Int. Inc. v. Cardinal Chem. Co.*, 28 U.S.P.Q.2d 1190 (Fed. Cir. 1993) (noting that the test of definiteness is whether one skilled in the art would understand the scope of the claim when read in light of the specification). Specifically, figure 12 describes one embodiment of the invention with two halves, *i.e.* two components, that can be brought together. (Page 18, lines 18-19). Therefore, the element of “at least two components” is definite.

Accordingly, in view of the foregoing, reconsideration and withdrawal of the rejections under 35 U.S.C. §112, second paragraph, are respectfully requested.

On the merits, the Examiner has rejected claims 26 and 28-29 as being anticipated by U.S. patent 5,520,574 to Wilson (“Wilson”).

It is submitted that this reference does not anticipate claims 26 and 28-29. Initially, in order for a Section 102 rejection to stand, the prior art reference must contain all of the elements

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of the claimed invention.. See *Lewmar Marine Inc. v. Barient Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987). Second, the prior art must contain an enabling disclosure. See *Chester v. Miller*, 15 U.S.P.Q.2d 1333, 1336 (Fed. Cir. 1990). A reference contains an enabling disclosure if a person of ordinary skill in the art could have combined the description of the invention in the prior art reference with his own knowledge of the art to have placed himself in possession of the invention. See *In re Donohue*, 226, U.S.P.Q. 619, 621 (Fed. Cir. 1985). All of the elements of the claimed invention are not found in Wilson.

As to claims 26, Wilson clearly does not disclose, suggest, or teach at least two components which, when brought together form a single block structure, containing a finishing cavity disposed therein. Further, as to claim 29, Wilson clearly does not disclose, suggest, or teach a relief surface.

Accordingly, Wilson does not anticipate claims 26 and 29. Claim 26 and 29 should therefore be found patentable. Claim 28 should also be found patentable as it depends from claim 26.

A Notice of Allowance is earnestly solicited.

The Commissioner is authorized to charge any additional fee that may be required to Deposit Account No. 50-0320.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP

By:



Ronald R. Santucci
Reg. No. 28,988
(212) 588-0800

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